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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,094	05/31/2001	Kazumasa Sato	450100-03252	9307

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745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER

LU, KUEN S

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/871,094

Applicant(s)

SATO ET AL.

Examiner

Kuen S Lu

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 16-18, 20-23 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-18, 20-23 and 25-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendments***

1. In responding to Applicant's amendments made to the claims, filed on October 6, 2004, has been considered by the Examiner. The Examiner has noted new issues were introduced to each of the independent claims 16 and 21, specifically the combination of limitation "when the electronic mail has been received, for causing the retrieved music file to be reproduced and for causing a signal to be supplied to a display means representative of the respective title and artist such that the retrieved music file is reproduced simultaneously or substantially simultaneously with the display of the respective title and/or artist".
2. As for the Applicants' REMARKS, filed on October 6, 2004, has been fully considered by the Examiner. For the Examiner's response, please see discussion in the section ***Response to Arguments***, following the Office Action for non-Final Rejection.

### ***Claim Objections***

3. Claims 16 and 21 are objected to because of the following informalities: the term "and/or" is ambiguous. The Examiner interprets it as "or" during the execution of this Office Action. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16-17, 20-22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over CASK (Japan Patent JP-11149434, English Abstract and Japanese Patent Drawing, hereafter "CASK") and in view of Maquaire et al. (U.S. Publication 2002/0107049, hereafter "Maquaire").

As per Claims 16 and 21, CASK teaches "receiving an electronic mail containing electronic mail sender information" (See the Abstract wherein CASK's the electronic-mail addresses of the calling party are received by the electronic-mail receiver and the calling party is recognized immediately is equivalent to Applicant's receiving an electronic mail containing electronic mail sender information); "reading a lookup table including electronic mail account information" (See the Abstract wherein CASK's the electronic-mail receiver receives the electronic-mail addresses of the calling party, an alarm sound is designated to each of the electronic-mail addresses and the calling party is recognized immediately is equivalent to Applicant's reading a lookup table including electronic mail account information); and an alarm "corresponding to said electronic mail account information" (See the Abstract wherein CASK's an alarm sound is designated to each of the electronic-mail addresses and the calling party is recognized immediately and the sound is output is equivalent to Applicant's an alarm corresponding to said electronic mail account information).

CASK does not specifically teach, instead of an alarm sound, "a music file" corresponding to each electronic mail account information and "a title and an artist associated with the music file".

However, Maquaire teaches receiving an incoming call, deriving the originating number, comparing the number to the numbers in a database, accessing the audio file corresponding to the matched number, playing the audio file and displaying the name and number to the user (See Figs. 2-4, Page 2, [0023] and [0028]).

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Maquaire's teaching with CASK's by using audio file to identify the incoming electronic mail and further displaying the audio file title and artist data while playing the file because both references are devoted to ordinary folks' daily, popular and routine communication and to the identification of the originating party of the communication, and the combined teaching would have enabled CASK system's users more completely and efficiently to identify the sender of electronic mail via the notes, title and artist of the audio media.

The combined Maquaire-CASK reference further teaches "retrieving said music file corresponded to said electronic mail account information of said electronic mail sender information received" (See CASK: in the Abstract where an alarm sound corresponding to each incoming electronic address is retrieved, and Maquaire: at Page 2, [0028] where audio file corresponding to an incoming call is retrieved).

Furthermore, the combined Maquaire-CASK reference teaches "when the electronic mail has been received, for causing the retrieved music file to be reproduced and for causing a signal to be supplied to a display means representative of the respective title and artist such that the retrieved music file is reproduced simultaneously or substantially simultaneously with the display of the respective title and/or artist" (See CASK: in the

Abstract where the calling party is immediately recognized and an alarm sound corresponding to the incoming electronic address is retrieved and output, Maquaire: at Figs. 2-4, Page 2, [0023] and [0028] where teaches receiving an incoming call, deriving the originating number, comparing the number to the numbers in a database, accessing the audio file corresponding to the matched number, playing the audio file and displaying the name and number to the user, and the combined reference: suggesting to display audio file title and artist).

As per Claims 17 and 22, the combined CASK-Maquaire reference further teaches electronic mail account information in said lookup table is an electronic mail sender account (See CASK: an alarm sound is corresponding to each incoming electronic mail address, and Maquaire: Fig. 4, and Page 2, [0028] where database table provides audio file to corresponding incoming call number data).

As per Claims 20 and 25, Maquaire teaches "lookup table is set up in advance" at Page 2, [0028] by showing database table having numbers ready for being compared to the incoming number.

6. Claims 18 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over CASK (Japan Patent JP-11149434, English Abstract and Japanese Patent Drawing, hereafter "CASK") in view of Maquaire et al. (U.S. Publication 2002/0107049, hereafter "Maquaire") as applied to claims 16 and 21 above, and further in view of Toyoda (U.S. Patent 6,441,916).

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As per Claims 18 and 23, the combined CASK-Maquaire reference teaches an electronic mail system playing audio file corresponding to each sender as previously described in claims 16-17 and 21-22 rejection.

The combined reference does not specifically teach "electronic mail account information in said lookup table is a domain name in said electronic mail sender account".

However, Toyoda teaches "electronic mail account information" is a domain name in said electronic mail sender account at col. 5, lines 50-60 by showing the domain name mgcs.co.jp.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Toyoda's teaching with the combined Maquaire-CASK reference by including domain name into the account information because network is a platform utilized by all references and the further combined teaching would have enabled CASK's system to send and receive electronic mails to and from all users in the WAN, as evidenced by the Patent Drawing, Page 16, Figure 1.

7. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over CASK (Japan Patent JP-11149434, English Abstract and Japanese Patent Drawing, hereafter "CASK") in view of Maquaire et al. (U.S. Publication 2002/0107049, hereafter "Maquaire") as applied to claims 16 and 21 above, and further in view of Hunter et al. (U.S. Publication 2002/0111912, hereafter "Hunter").

As per Claims 18 and 23, the combined CASK-Maquaire reference teaches an electronic mail system playing audio file corresponding to each sender and displaying the title and artist as previously described in claims 16-17 and 21-22 rejection.

The combined reference does not specifically teach "the respective music file includes a picture file associated with the respective artist, and wherein the causing means causes the picture to be displayed on said display means when the electronic mail has been received".

However, Hunter teaches "the respective music file includes a picture file associated with the respective artist, and wherein the causing means causes the picture to be displayed on said display means when the electronic mail has been received" (See Fig. 10 and Page 7, [0080] where a multiple level of selecting audio files permits identification of specific artists and displaying artist's picture).

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Hunter's teaching with the combined Maquaire-CASK reference by displaying audio file and its artist information, such as title, name and picture and the combined teaching would have enabled CASK system's users more completely and efficiently to identify the sender of electronic mail via the notes, title, artist name and artist picture of the audio media.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 16-18, 20-23 and 25-27 have been considered but are moot in view of the new ground(s) of rejection.

9. The prior art made of record



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A. U.S. Patent No. 6,441,916

B. U.S. Pub. No. 2002/0107049

C. U.S. Pub. No. 2002/0111912

N. Japan Patent JP-11149434, English Abstract and Japanese Patent Drawing

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

D. U.S. Patent No. 6,212,265

E. U.S. Patent No. 6,556,255

F. U.S. Pub. No. 2004/0030744

G. U.S. Patent No. 6,389,455

H. U.S. Pub. No. 2002/0166119

### ***Conclusions***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuen S Lu whose telephone number is 571-272-4114.

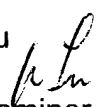
The examiner can normally be reached on 8 AM to 5 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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Kuen S. Lu

  
Patent Examiner

November 17, 2004



Luke Wassum

Primary Examiner

November 17, 2004